



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,967	08/10/2000	Robert J. Klein	47171-00272usc1	6269

30223 7590 02/26/2003

JENKENS & GILCHRIST, P.C.
225 WEST WASHINGTON
SUITE 2600
CHICAGO, IL 60606

EXAMINER

SHAPIRO, JEFFERY A

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED

INIT. SP DATE: 3-4-03

Resp to Provokes
ACTION: Adv DATE: 4-26-03
Deadline 8-26-03

RECEIVED
MAR 4 2003
CHI-DOCKETING

SK

Office Action Summary	Application No.	Applicant(s)	
	09/635,967	KLEIN ET AL.	
	Examiner	Art Unit	
	Jeffrey A. Shapiro	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 157, 158, 164-208 is/are pending in the application.
- 4a) Of the above claim(s) 174-180, 182-189, 193-195 and 201-203 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 157, 158, 164-173, 181, 190-192, 196-200 and 204-208 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species I, directed towards Claims 157, 158, 164-173, 181, 190-192, 196-200 and 204-208 in Paper No. 14 is acknowledged.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 157, 158, 181, and 190 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto 4,653,647. Notice operation section 1 which is for designating an operation mode by which an operator designates which pocket 5, 6 or 7 the various notes are sent. Hashimoto further discloses as follows.

As described in Claim 157, 158, 168, 169, 170-173 181, 190 and 204;

1. a discrimination unit (11) (see col. 2, lines 16-21)
2. an interface (see figure 3, col. 3, lines 10-45 and col. 4, lines 1-25), capable of permitting a user to specify error condition operation modes);
3. a memory (33), capable of storing user information;
4. plural output receptacles (5 and 6) (note that there are two output (receptacles illustrated in the figures);
5. a transport mechanism (4, 10 and 31);
6. a mode selection element (15-18);

Note that the elements of Hashimoto are adapted to perform the functions and limitations of Applicants' independent claims.

Claim Rejections - 35 USC § 103

4. Claims 191-192, 196 and 205-208 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto. Hashimoto discloses the apparatus as described above. Hashimoto further discloses the following.

As described in Claim 191, 192 and 196;

7. a particular receptacle is specified (note that it would be obvious to allow a person to choose which receptacle to feed to, since the system automatically performs this operation and it would be considered obvious to make an automatic operation manual and vice-versa)

As described in Claim 205;

8. the user is permitted to define a name for the stored user information specifying how the plurality of error conditions are to be handled (note that it would be obvious to use a name to identify the information as it is necessary to do so if a file is to be stored for ready, organized access in a computer memory);

As described in Claim 206, 207 and 208;

9. the memory is a nonvolatile memory (note that regardless of the type of memory, the system would still work the same as described in Applicants' claims, as written—note also that Hashimoto's memory is

suggested to be nonvolatile, or a memory which preserves itself with or without power, since it would be expected that such information and data would be preserved so as to eliminate excess reentry of the same information—see also col. 4, lines 31-38—note also that Minami et al discloses use of ROM (78) and RAM (79) which are generally made nonvolatile);

5. Claims 197-200 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto in view of Minami et al. Hashimoto discloses the apparatus as described above. Hashimoto does not expressly disclose, but Minami et al discloses the following

As described in Claim 197, 198, 199, 200;

10. user information specifies that the bill is to be stopped at a predetermined position within a transport mechanism of the evaluation device (see col. 9, lines 27-40, noting that predetermined operations are performed which includes stopping of the sheet at a particular point in the transport mechanism);

Both Hashimoto and Minami et al are analogous art as they both concern bill transport within a document evaluation apparatus.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have used the stopping routine with predetermined operations of Minami et al in the system of Hashimoto.

The suggestion/motivation would have been to stop transport of a bill that exhibits an error condition, such as being conveyed obliquely with respect to the transport direction or that it has a folded-over or dog-eared condition, for example.

Therefore, it would have been obvious to combine Hashimoto and Minami et al in order to obtain the invention as specified in Claims 197-200.

6. Claims 164-167 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto 4,653,647 in view of Cargill et al 5,430,664. Hashimoto discloses all of the features of the applicant's claimed invention, as described above. Note that per the abstract of Hashimoto, for example, when a first pocket is filled with currency notes, the transport path is automatically switched to a second pocket. Note also figure 3, which shows human interface with the device of Hashimoto.

Cargill et al discloses particulars of control circuitry for allowing error detection and operator control.

Both Hashimoto and Cargill et al are analogous art as they both concern bill counting and sorting apparatus.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have used the control particulars of Cargill et al in the bill sorting and stacking apparatus of Hashimoto.

The suggestion/motivation for doing so would have been to provide digital control networking capability to "coordinate operations of counting and verifying documents".

See abstract of Cargill et al.

Therefore, it would have been obvious to combine Hashimoto and Cargill et al in order to obtain the invention as specified in Claims 164-167.

Claims 157, 158 and 164-167 are rejected under 35 U.S.C. 103(a) as being unpatentable over Omatu et al 5,729,623 in view of Molbak et al. Omatu et al discloses a bill sorter with neural network and artificially intelligent decision making capability in a bill sorter having two output receptacles, which necessarily has a human interface.

Molbak et al discloses particulars of operator interface and allowing error detection and operator control (operator intervention). See figures 2, 4 and 5.

Both Omatu et al and Molbak et al are analogous art as they both concern currency counting and sorting apparatus.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have used the operator intervention particulars of Molbak et al in the bill sorting and stacking apparatus of Omatu et al.

The suggestion/motivation for doing so would have been to provide user control over the sorting process. See col. 2, lines 15-22 of Molbak et al.

Therefore, it would have been obvious to combine Omatu et al and Molbak et al in order to obtain the invention as specified in Claims 157, 158 and 164-167.

Terminal Disclaimer

7. The terminal disclaimer filed on 4/30/02 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US

Art Unit: 3653

Patent 6,311,819 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

8. Applicant's arguments filed 1/17/02 have been fully considered but they are not persuasive. Applicants assert that the system of Hashimoto and Cargill do not disclose the limitations of Applicants' Claims. However, it is noted that Hashimoto, for example, as described above, discloses a system having the components to effectuate the action described in Applicants' claims. Molbak and Omatu also appear to still read on the claims as currently written. Therefore, Claims 157, 158, 164-173, 181, 190-192, 196-200 and 204-208 are rejected.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3653

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)306-4173. The fax phone numbers for the organization where this application or proceeding is assigned are (703)306-4195 for regular communications and (703)306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

DONALD P. WALSH
SUPERVISOR, PATENT EXAMINER
TELEPHONE (703) 306-4173



Jeffrey A. Shapiro
Patent Examiner,
Art Unit 3653

February 21, 2003